

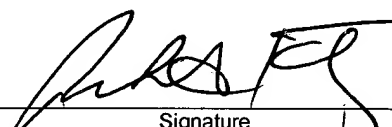
Doc Code: AP.PRE.REQ

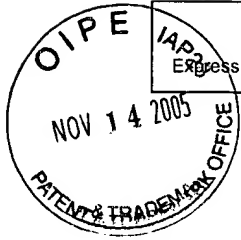
PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 02559/100F420-US1
	Application Number 09/422,387-Conf. #5469	Filed October 21, 1999
	First Named Inventor Moshe Zilberstein et al.	
	Art Unit 2151	Examiner K. Q. Dinh
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number 47,698</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p> <div><div> Signature Richard J. Katz Typed or printed name (212) 527-7700 Telephone number November 14, 2005 Date</div></div> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of 1 forms are submitted.</p>		



Express Mail Label No. _____

Dated: _____

File No. 02559/100F420-US1
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Moshe Zilberstein, et al.

Confirmation No. 5469

Application No.: 09/422,387

Art Unit: 2151

Filed: October 21, 1999

Examiner: K.Q. Dinh

For: SYSTEM AND METHOD FOR PROCESSING
AND PRESENTING INTERNET USAGE
INFORMATION TO FACILITATE USER
COMMUNICATIONS

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Concurrent with the filing of a Notice of Appeal, and in accordance with the Pre-Appeal Brief Conference Pilot Program, Applicants hereby request a pre-appeal brief review of the rejection mailed June 13, 2005 in the above-identified application. No amendments are being filed with this request.

Claims 7-11, 14, 15 and 20-26 are pending in the application, with claims 7-11, 14, 15 and 20-26 having been twice rejected. An appeal is proper in accordance with 37 C.F.R. § 41.31(a), which provides that "[e]very applicant, any of whose claims has been twice rejected, may appeal from the decision of the examiner to the Board"

The sole question on appeal is whether the rejection of all claims as being unpatentable over the combination of U.S. Patent No. 6,381,635 to Hoyer et al. (“Hoyer”) in view of U.S. Patent No. 6,578,078 to Smith et al. (“Smith”) is correct. *See* June 13, 2005 Office Action, item 3, pages 3-8. Applicants submit that the Examiner errs in rejecting claims 7-11, 14, 15 and 20-26 as being obvious over the combination of Hoyer and Smith.

In the present application, the claimed inventions are directed to methods which provide “usage information of a first web site designated by a user.” (Claim 7, preamble.) Claim 7 includes the step of “transmitting data representative of the usage to the user by way of a monitor window when the user is connected to any other website on the communication network.” Thus, the claimed invention transmits website usage information to a user, while the user is connected to any other website. The usage information is presented to the user by way of a monitor window.

A. The Cited Combination Fails To Result in the Claimed Invention

The Examiner acknowledges that Hoyer “does not specifically disclose transferring data to user when user connected to other web sites.” The Examiner relies on Smith as disclosing this feature “in the same usage monitoring environment.” (June 13, 2005 Office Action, page 3.)

Hoyer discloses a method and apparatus for displaying multiple performance measurements of a web site. Hoyer discloses a performance monitor 200 that allows an administrator to assess the performance of Internet web sites (e.g., CPU utilization, web server response time, web server hit count and rate). “The performance monitor 200 includes a client side component 210 and a server side component 225. As depicted, the client side component

210 is coupled to the server side component 225 via the Internet.” (Hoyer, column 7, lines 22-29, and Fig. 3 (emphasis added).) *See* December 23, 2004 Response to Office Action, page 2.

Smith discloses a method for maintaining the integrity of URL references to resources embedded within web sites. The resource is static data (e.g., web pages, documents, etc.), and not usage information. Smith addresses the problems associated with changes in the location of the resources by dealing with broken hyperlinks to the resources that have been moved. When a server receives a message from a client requesting a resource via its URL reference, the server looks up the location of the resource in an indirection table and forwards a copy of the resource to the client. The indirection table contains entries that map a URL to each resource, as documents are moved or deleted, their indirection table entries must be updated. (Smith, column 11, lines 48-63.) *See* December 23, 2004 Response to Office Action, page 3.

Applicant submits that Hoyer, as acknowledged by the Examiner, discloses that the client side component, which receives performance data, is coupled to the server side component, which is being monitored. Similarly, Smith discloses a server that forwards a copy of a resource’s URL to the client while the client is connected to the **web site in which the resource is embedded**. Applicant submits that Hoyer and Smith would result in delivering embedded static data along with usage information of the website to a user, while the user is connected to that website.

Pending independent claims 7, 14 and 15 each recite “transmitting data representative of the usage to the user by way of a monitor window **when the user is connected to any other website on the communication network**.” (Emphasis added.) Independent claim 21 recites

similar subject matter. Applicants submit that the combination of Hoyer and Smith neither discloses nor suggests transmitting usage data to the user while “connected to any other website,” nor does the combination disclose a monitor window on the any other website. Thus, the combination of Hoyer and Smith does not result in the claimed invention. Therefore, the Examiner has not met the legal burden of establishing a *prima facie* case of obviousness.

B. There Is No Motivation To Combine Hoyer and Smith

The Examiner has not established a *prima facie* case of obviousness for combining Hoyer and Smith. The Examiner has not established a motivation (a reason or suggestion) in the art that would lead an individual to combine the references. According to the Examiner, a person of ordinary skill in the art would look to modify Hoyer in view of Smith in order to extend Hoyer to provide usage information on a website to a user connected to any other website, which the Examiner acknowledges is missing from Hoyer. The Examiner contends that Smith is “in the same usage monitoring environment” as Hoyer. (June 13, 2005 Office Action, page 3.)

Applicants disagree with the Examiner’s characterization that Hoyer and Smith are “in the same usage monitoring environment.” While Hoyer is in the performance usage monitoring environment, Smith relates to maintaining URL hyperlinks to static data embedded on a website. Smith does not discloses monitoring performance usage information.


The Federal Circuit has held that in considering obviousness, the critical inquiry is whether something in the prior art as a whole suggests the desirability, and thus the obviousness, of making a combination. *In re Newell*, 891 F.2d 899, 901-02, 13 U.S.P.Q. 2d 1248, 1250 (Fed. Cir. 1992). The Examiner must show some objective teaching from the art that would lead an

individual to combine the references, *i.e.*, the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q. 2d 1780, 1783 (Fed. Cir. 1992).

Even if the combination resulted in the claimed invention, Applicant submits that the Examiner has failed to met the burden of establishing the *prima facie* case of how a person of ordinary skill in the art of performance usage monitoring would be motivated to look to Smith, which maintains hyperlinks of static documents.

Applicants believe that claims 7-11, 14, 15 and 20-26 are patentable over the combination of Hoyer and Smith. Accordingly, Applicants request that the present rejection be withdrawn and the claims be passed to allowance.

Respectfully submitted,



Richard J. Katz
Reg. No. 47,698
Attorney for Applicants

Dated: November 14, 2005

DARBY & DARBY, . P.C.
Post Office Box 5257
New York, N.Y. 10150-5257
Phone: (212) 527-7700